

REMARKS

Claims 1-24 are pending in the application and all stand rejected. Reconsideration and allowance of all pending claims is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1-2, 11, 13-15, 17, 19-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (U.S. Patent No. 6,418,536) (Park hereinafter) in view of Belt et al (U.S. Patent No. 5,303,171) (Belt hereinafter).

Claims 3-10, 12-13, 16, 18-19 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park and in further view of Barrett (U.S. Patent No. 6,782,471) (Barrett hereinafter). These rejections are not applicable to the pending claims.

Independent claims 1 and 11 each recite, among other things, "analyzing the sensed information to determine if the IHS is currently in an unusable state; and entering a reduced power mode, by the IHS, if it is found that the IHS is currently in the unusable state." Similarly, Independent claims 17 and 21 each recite, among other things, "nonvolatile storage, coupled to the processor, for storing control software for analyzing the sensed information to determine if the portable IHS is currently in an unusable state and for causing the portable IHS to enter a reduced power mode if it is found that the portable IHS is currently in the unusable state."

However, it is submitted that none of the references, either alone, or in any combination, teach or suggest all of the elements of the pending claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, it is submitted that the references, alone, or in any combination, do not teach or suggest, among other things, "analyzing the sensed information to determine if the IHS is currently in an unusable state; and entering a reduced power mode, by the IHS, if it is found that the IHS is currently in the unusable state" or "nonvolatile storage, coupled to the processor, for storing control software for analyzing the sensed information to determine if the portable IHS is currently in an unusable state and for causing the portable IHS to enter a reduced power mode if it is found that the portable IHS is currently in the unusable state," as recited in the pending claims.

First, the Examiner conceded on pages 2 and 3 of the Office Action that Park "does not teach that the power mode is entered when the IHS is determined to be in an unusable state. . . [and Park] does not teach that the reduced power mode is entered when the IHS is determined to be in an unusable state." Second, it is submitted that Belt does not teach or suggest a system that enters a reduced power mode when the IHS is in an unusable state, as claimed on page 3 of the Office Action. And third, Barrett is not relied on for teaching or suggesting a system that enters a reduced power mode when the IHS is in an unusable state.

The rejection points to Column1, lines 64-67 and column 2, lines 1-24 of Belt to teach determining an unusable state and entering a reduced power mode when the IHS is in this unusable state. To the contrary, it is submitted that the cited sections relate to "movement of the lid to its closed position", "movement between open and closed positions", and "when the lid is moved to its closed position." It is widely known to those having ordinary skill in the art that a portable IHS may be operational when the lid is closed. For example, the IHS may be coupled to an external keyboard, and an external display device and yet operate as if the lid is opened. Thus, it is submitted that the cited sections of Belt do not teach an unusable state as defined in the present application. Furthermore, a search of Belt reveals that the terms "usable" and "unusable" are not even found in the specification of Belt. Thus, Belt could not teach determining an unusable state and entering a reduced power mode when the IHS is in this unusable state, as defined in the specification and claims of the pending application.

The deficiencies of both Park and Belt are not remedied by Barrett. As discussed above, Barrett is not relied on for teaching or suggesting a system that enters a reduced power mode when the IHS is in an unusable state. To the contrary, Barrett states that "the present invention provides for monitoring a device [a photocopier (see Fig. 1), not an IHS] for a disturbance so as to detect a disturbance, wherein the monitoring occurs while the device is in

an inactive [NOT an unusable] state." Abstract of Barrett. The inactive state of Barrett is define in column 1, lines 52-52 as "no power, low power, or standby state." Similarly, as with both Park and Belt, neither of the terms "usable" or "unusable" are not found in the specification. As a result, it is submitted that Barrett does not teach determining an unusable state and entering a reduced power mode when the IHS is in this unusable state, as defined in the specification and claims of the pending application and thus, cannot remedy the deficiencies of Park and Belt.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable. Thus, a notice of allowance of independent claims 1, 11, 17, and 21 and their respective dependent claims is respectively requested.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In combining multiple references for a 103 rejection, the Supreme Court has ruled that the "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739. The Court stated that "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify **a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741, *emphasis added.*

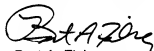
In the present case, it is improper to combine Barrett with Park and Belt. Each of the pending claims recites an information handling system (IHS), yet a search of Barrett reveals no references to an "information handling system" or an "IHS" in Barrett. To the contrary, Barrett defines a "device" as a "printer, facsimile, copier or scanner." Column 1, line 49.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, it is submitted that independent claims 1, 11, 17, and 21 and their respective dependent claims are submitted to be allowable. In view of all of the above, the allowance of all pending claims is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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